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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,286	01/26/2001	William T. Wilkinson	WIL-107US	9173
31344	7590	01/04/2006	EXAMINER	
RATNERPRESTIA			RETTA, YEHDEGA	
P.O. BOX 1596				
WILMINGTON, DE 19899			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 01/04/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/771,286	WILKINSON, WILLIAM T.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/27/01, 5/21/01</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims merely manipulate an abstract idea (establishing, identifying, providing, evaluating and designating) or perform a purely mathematical algorithm without limitation to any practical application. A process, which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335, 200 USPQ at 139). The result of the claim as a whole or the manipulations of data as recited in the claims is not applied in any manner so as to be tangibly used in a concrete manner and hence produce a useful, concrete and tangible result. Hence, the invention of claims 1-22 is merely directed to a hypothetical mental exercise that manipulates an abstract idea or manipulates data/information to determine a number without requiring the use of the determined number and hence are without a claimed concrete and tangible practical application of the abstract idea, (note *In re Beauregard* 35 USPQ2d 1383 (CAFC 1995) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.* 47 USPQ2d 1596 (CAFC 1998)).

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of

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producing something that is concrete, tangible and useful. See AT &T, 172 F.3d at 1358, 50 USPQ2d at 1452. Thus, the result appears to be useful however is not concrete or tangible. The result of the claim as a whole or the manipulations of data as recited in the claims is not applied in any manner so as to be tangibly used in a concrete manner and hence produce a useful, concrete and tangible result. Hence, the invention of claims 1-22 is merely directed to a hypothetical mental exercise that manipulates an abstract idea or manipulates information to determine a winner and awarding incentive.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-7 are rejected under 35 U.S.C. 102(a) as being anticipated by “Defense Taps 2 Finalists for Jet Contract; Military: Boeing and Lockheed Martin will build prototypes of fighter. McDonnell Douglas loses out but Southland will get a piece of the project”, Los Angeles Times (pre-1997 Fulltext), Los Angeles, Calif.: Nov. 17, 1996 pg.1 (hereinafter “Los Angeles Times”).

Regarding claims 1-7, Los Angeles Times teaches establishing a competition between at least two identifiably distinct R&D teams to work on the project; identifying a project manager to oversee the competition (personal at Pentagon in charge of the competition); providing an incentive for winning the competition (competing for the contract (\$1.1 billion to develop demonstrator aircraft); each team working on the project

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and developing proposed solution (to develop the prototype) periodically evaluating the progress of each team to determine if any team can be declared a winner or can be eliminated from the competition (cutting out McDonnell Douglas and then the winner of the final product); designating a winning solution and a winning team and awarding the incentive to the winning team (the winner of the final product contract between the two competing) (see pg. 1&2); allowing a plurality of teams to bid to enter the competition and choosing based on upon bids submitted by those teams (see pg. 1). Whether the teams are external or internal teams does not change the process of designating a winner team.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Defense Taps 2 Finalists for Jet Contract; Military: Boeing and Lockheed Martin will build prototypes of fighter. McDonnell Douglas loses out but Southland will get a piece of the project”, Los Angeles Times (pre-1997 Fulltext), Los Angeles, Calif.: Nov. 17, 1996 pg.1 (hereinafter “Los Angeles Times”).

Regarding claim 8, Los Angeles Times does not explicitly teach an independent third party providing an evaluation of the teams’ progress. Official notice is taken that is old and well known for companies to hire an outside consultant (third part) for

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consultation. It would have been obvious to one of ordinary skill in the art at the time of the invention to hire third party to evaluate the progress since a consultant or expert would be familiar with the project and are better trained and experienced group.

Regarding claims 9-22, the claimed features are standard practice of research and development project evaluation and selection. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include such features in order to manage and run the R&D project efficiently and effectively in order to provide a marketable and highly profitable product.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Giants Fight For Joint Strike Fighter; Flug Revue online; January 1997;  
<http://www.flug-revue.rotor.com/Frheft/FRH9701?FR9701c.htm>.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR

  
RETTA YEHDEGA  
PRIMARY EXAMINER